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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,494	11/19/2003	Kazuo Okada	245550US2	5961

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EXAMINER	
HSU, RYAN	
ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
07/28/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/715,494	OKADA, KAZUO	
	Examiner	Art Unit	
	RYAN HSU	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 February 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,6-8 and 12-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,6-8 and 12-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to the amendments filed on 4/28/08, claims 1 and 3 have been amended and claims 13 and 14 have been newly added. Claims 1-3, 6-8, and 12-14 are pending in the current application.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-7 and claims 1-10 of copending Application No. 10/697,238 and 10/697,027. Although the conflicting claims are not identical, they are not patentably distinct from each other because although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed towards a gaming machine that comprises a variable display device that displays designs or symbols. Additionally, they include a front electric display which consists from a group of at

least a liquid crystal display panel or series of light emitting diodes. This display uses a light guiding plate to create an illuminating effect for the display device so that a gaming machine can produce several different arrays of symbols and designs that compliment the basic reel display device commonly found in game machines. The two sets of claims have simply been rearranged so that they are claimed in different orders and are directed towards the same device except one uses a light emitting diode and the other a liquid crystal display. However, these are different forms of lighting display devices and perform the same function therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use either type of lighting device to perform the same functions as described in the claims. Therefore it would be obvious that these two inventions are not patentably distinct but simply have used alternative synonyms and language structure to detail the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 6-8, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrow et al. (US 2003/0064771 A1) and Dunn (US 2002/0195773 A1) and Feinberg (US 5,910,048) further in view of deKeller (US 7,179,167 B2).

Regarding claims 1 and 12, Morrow et al. teaches a gaming machine comprising: a display unit configured to variably and statically display a plurality of symbols and an electrical display provided above the display unit and configured to display a pay table in which a winning combination is associated with a predetermined prize to be awarded when the winning combination is formed; and a controller configured to, when the winning combination is formed depending on a combination of the symbols statically displayed on the display unit, awarding a

prize associated with the formed winning combination based on the pay table. Furthermore, Morrow teaches a controller that can adapt and switch between different pay tables by storing pay tables to be displayed on the electrical display based on pay amount data of a winning combination stored in a ROM (*see display [30] of Fig. 1 and Fig. 3 of the respective related description thereof*). However, Morrow is silent with respect to a controller that switches from display the pay table on the electrical display to a second pay table different from the pay table in an identical game and the switches from the pay table to the second pay table by changing the predetermined prize associated with the winning combination or by changing a winning probability of the winning combination in the pay table.

In a related gaming patent, Dunn teaches a display on a game machine wherein a game machine switches between the display of a first pay table and a second pay table by changing the predetermined prize associated with the winning combination (*see paragraph [0052, 0056-0057]*). Dunn teaches that one would be motivated to incorporate such a feature in order to heighten the player excitement over the possibility of winning larger payouts. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate in a game machine the ability to display any changes may occur in a gaming machine involving the payout of the game a player is playing. However, incorporating Morrow and Dunn would still lack in specifically teaching multiple pay tables that alter the winning probability of a pay table.

In a related gaming patent, Feinberg teaches a gaming machine that has a game controller that is configured to generate a special game state that is triggered without an additional bet, the special game state giving an advantage to a player based on a predetermined condition (*see col.*

4: ln 15-col. 5: ln 30). Furthermore, Feinberg teaches a special game state that changes the predetermined prize associated with the winning combination and by changing a winning probability of the winning combination in the pay table, the winning probability of the winning combination in the pay table being different from a winning probability of the winning combination of the second pay table. Feinberg teaches that the motivation to incorporate such a feature is to prevent a player who is losing a predetermined amount of money to be given a more probable chance of winning so the player does not lose more than a limit (*see col. 5: ln 5-col. 6: ln 21*). Feinberg teaches that a feature of offering a special game state with an increased chance of winning will allow a player to reduce the amount that the player would lose (*see col. 6: ln 21-50*). Thus it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of Feinberg with that of Morrow and Dunn at the time the invention was made to improve the playability of a game machine.

In a related gaming patent, deKeller teaches a game machine that allows a player depending on the game state of the game different payout probabilities for the player of the game (*see Fig. 1 and the related description thereof*). One would be motivated to incorporate such a feature as it would provide the player with an added element of risk where the player may receive more of a payout receive as consolation some of the payout so that they have a chance to win back some of the money. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the features of deKeller with that of Morrow and Dunn at the time the invention was made.

Regarding claims 13-14, Feinberg teaches a stop order information necessary for formation of the winning combination is given to the player in the special game state (*ie: linking*

up the winning outcome from the random generated outcome with that of the pay award on the paytable) (*see Fig. 1 and the related description thereof*) and a pay amount of the winning combination in the pay table is changed by an input operation of the player (*ie: participation by the player*).

Claims 2-3, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrow et al. (US 2003/0064771 A1) and Dunn (US 2002/0195773 A1) and deKeller (US 7,179,167 B2) and Feinberg (US 5,910,048) as applied to claims above, and further in view of Muir et al. (US 2005/0192090 A1).

Morrow, Dunn, deKeller, and Feinberg teach a gaming machine that displays a pay table on a secondary display and has the ability through the use of a controller to switch between a first and second pay table and display it on the secondary display. However, Morrow, Dunn, and deKeller are silent with respect to structural elements of a gaming machine and shielding elements found on the gaming machine. In a related gaming patent, Muir teaches the structural of a gaming machine that has the following features.

Regarding claim 2, Muir et al. teaches a gaming machine comprising a translucent electrical display provided in front of the variable display unit (*see Fig. 8 and the related description thereof*).

Regarding claim 3, Muir et al. teaches a game machine wherein the translucent electrical display executes shielding control for making at least part of the variable display unit invisible to the player during the special game state, based on a prescribed condition (*see Fig. 6-7 and the related description thereof*).

Regarding claim 6, Muir et al. teaches a game machine wherein the electrical display displays an image for decorating the gaming machine (*see display [52] of Fig. 4 and the related description thereof*).

Regarding claim 7, Muir et al. teaches a game machine wherein the translucent electrical display displays an image according to a game state while executing the shielding control (*see Fig. 6-7 and the related description thereof*).

Regarding claim 8, Muir et al. teaches a game machine wherein the translucent electrical display executes the shielding control to indicate an advantageous way of operating the gaming machine to the player (*ie: bonus symbol occurring for advantageous result for player*) (*see Fig. 6-7 and the related description thereof*).

One would be motivated to incorporate the teachings of Muir with that of Morrow, Dunn and deKeller in order to provide a gaming machine that had a display screen that incorporates the benefits of a variable mechanical game display as well as the adaptability of an electronic display. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Muir with that of Morrow, Dunn, deKeller and Feinberg at the time the invention was made.

Response to Arguments

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RYAN HSU whose telephone number is (571)272-7148. The examiner can normally be reached on 9:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

RH
July 14, 2008